IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: GANDOLPH, et al.   Examiner: DASGUPTA, Soumya

Serial No: 10/584,649   Group Art Unit: 2176

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Confirmation No.: 8142

For: METHOD AND APPARATUS FOR GENERATING AN ELECTRONIC MENU

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Appellant appeals the status of Claims 1 – 7 and 12 – 20 as presented in response to the final Office Action dated April 29, 2009, and submits this Appeal Brief.

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1.   __Real Party in Interest__

The real party in interest is THOMSON LICENSING, the assignee of the entire right, title and interest in and to the subject application by virtue of an assignment recorded with the Patent Office on May 26, 2005 at Reel/Frame 018071/0547.

2.   __Related Appeals and Interferences__

Appellant is not aware of any appeals or interferences related to the present application.

3.   __Status of Claims__

a)   Claims 1 – 7 and 12 – 20 are pending. Claims 1, 13 and 15 are independent.

b)   Claims 1 – 7 and 12 – 20 stand rejected and are under appeal.

c)   Claims 8 – 11 are cancelled.

4.   __Status of Amendments__

An amendment under 37 C.F.R. § 1.116, mailed to the PTO on February 6, 2009, in response to a final Office Action dated December 10, 2008. However, an Advisory Action of February 18, 2009, indicated that the amendment filed on February 6, 2009, was not entered. Subsequently, a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114, is mailed on March 10, 2009, and the amendment previously filed on February 6, 2009, was entered by virtue of the RCE. No responses/amendments were

filed subsequent to the March 10, 2009 RCE. The claims listed in section 8 "Claims

Appendix" of this Appeal Brief correspond to the claims submitted in Appellant's

amendment on February 6, 2009.

5. Summary of Claimed Subject Matter[1]

The claimed invention, as recited in claim 1, is directed to a method for

automatically generating an electronic menu including a plurality of menu pages (page

4, lines 4 – 6), wherein menu pages contain selectable menu items with associated

commands to be executed upon activation of the respective menu item (page 4, lines 6

– 8), the method comprising associating a page number with each menu page (page 4,

lines 9 – 10); a first menu page containing at least one menu item with an associated

command and associated data (page 4, lines 10 – 12), wherein the command

associated with the menu item comprises switching to another menu page (page 4,

lines 13 – 14); defining a range of page numbers based upon said data associated with

said command (page 4, lines 12 – 13); detecting the page numbers of the available

menu pages (page 4, lines 14 – 15); and selecting a second menu page upon activation

of said menu item for switching to another menu page (page 4, lines 15 – 17), wherein

the second menu page has the first or last page number from among the available

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[1] It should be explicitly noted that it is not the Appellant's intention that the currently claimed or
described embodiments be limited to operation within the illustrative embodiments described
below beyond what is required by the claim language. Further description of the illustrative
embodiments are provided indicating portions of the claims which cover the illustrative
embodiments merely for compliance with requirements of this appeal without intending to read
any further interpreted limitations into the claims as presented.

menu pages within the defined range of menu pages (page 4, lines 17 – 20) and wherein the first and second menu pages are retrieved from different storage media (page 2, lines 22 – 24).

The claimed invention, as recited in claim 13, is directed to an apparatus (page 5, line 8) for automatically generating an electronic menu including a plurality of menu pages (page 4, lines 5 – 6), wherein each menu page contains selectable menu items with associated commands to be executed upon activation of the respective menu item (page 4, lines 6 – 8), wherein the apparatus has means for detecting a current menu page number (page 5, line 9); means for retrieving from at least two different storage media menu related data and other data being selectable through the menu (page 2, lines 22 – 24); means for detecting from a request for displaying another menu page the allowed range of page numbers of the next menu page to be displayed (page 5, lines 9 – 12); means for detecting which of the available menu pages has the next higher or lower number (page 5, lines 12 – 13); and means for selecting said detected menu page (page 5, line 14).

The claimed invention, as recited in claim 15, is directed to an optical storage medium for storing audio-visual content and menu data for a multi-page menu (page 5, lines 17 – 19), wherein menu pages have page numbers (page 5, line 19), and wherein at least a first menu page contains a command for selecting a second menu page (page 5, lines 19 – 21), wherein the command for selecting a second menu page specifies a range of menu pages to select (page 5, lines 21 – 23), and a predefined rule specifies which menu page of the range of menu pages is selected next (page 5, lines 23 – 25); and for at least one page number within said range no relating menu page is stored on

the optical storage medium (page 5, lines 25 – 27).

6.   Grounds of Rejection to be Reviewed on Appeal

A.   Whether claims 5 and 17 are properly rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

B.   Whether claims 1 – 7 and 12 – 20 are properly rejected under 35 U.S.C. §102(b) over Goldsmith et al. (US 2005/0076309, hereinafter "Goldsmith").

7.   Argument

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below.

A.   Claim 5 and 17 are not properly rejected under 35 U.S.C. §112, second paragraph.

As indicated in In re Hammack, supra, 427 F.2d at 1382, 166 USPQ at 208, the purpose of the requirement stated in the second paragraph of 35 U.S.C. 112 is:

> *to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.*

It is respectfully submitted that the Examiner failed to establish a *prima facie* case of indefiniteness.

Appellant's claims 5 and 17, each in part, requires:

"wherein from among the available menu pages within the defined range, the menu page with the next higher page number relative to the page number of said first menu page is selected, if the numeric value indicates a higher page number than the page number of the first menu page."

In the Office Action, page 2, in rejecting claims 5 and 17 under 35 U.S.C. 112, second paragraph, the Examiner alleged that the phrase:

"wherein <u>number</u> from among the available menu pages within the defined range, the menu page with the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number of the first menu page" (Emphasis added)

is confusing, poorly worded and not clearly understood by one of ordinary skill in the art. However, Appellant submits that the phrase cited by the Examiner does not match exactly as Appellant's claim language. The phrase cited by Examiner's contains an extraneous word "*number*," which is not present in Appellant's claims 5 and 17. Appellant submits that the claims language as recited in each of claims 5 and 17 is clear, precise and definite; and that the above phrase as cited in the Office Action, page 2, mischaracterizes the claimed invention and should not be used.

Furthermore, on page 13 of the Office Action, the Examiner asserted that the explanation provided by Appellant in a previous response dated February 6, 2009, is not

sufficient to obviate the rejection under 35 U.S.C. 112, second paragraph.

Appellant submits that the above claim language as recited in claims 5 and 17 is readily understood by a skilled person in the art, because the claim language clearly discloses the candidates (*from among the available menu pages within the defined range*); the selection method (*the menu page with the next higher page number relative to the page number of said first menu page is selected*); and the condition (*if the numeric value indicates a higher page number than the page number of the first menu page*). Therefore, a skilled person can readily and accurately determine the boundaries of the claimed invention, because, as shown above, the subject, action and condition are clearly spelled out in the claim language.

In view of at least the foregoing, Appellant submits that claims 5 and 17 are not vague or indefinite under 35 U.S.C. 112, second paragraph, and that the rejection of claims 5 and 17 should be reversed.

B.   Claims 1 – 7 and 12 – 20 are not properly rejected under 35 U.S.C. §102(b) over Goldsmith.

In order for a reference to anticipate a claim the MPEP 2131 requires the reference to teach each and every element of that claim. It is respectfully submitted that the Examiner failed to establish a *prima facie* case of anticipation.

1. Claim 1

Appellant's claim 1, in part, requires:

"*associating a <u>page number</u> with each menu page.*" (Emphasis added)

In the Office Action, page 4, the Examiner alleged that Goldsmith, Fig. 5, paragraphs [0010] and [0011], discloses the above claimed feature. Appellant respectfully disagrees.

Appellant submits Goldsmith only discloses that the menu options are associated with pointers, not with page numbers. In the Office Action, page 4, the Examiner asserted that "page numbers" are functionally equivalent to pointers to other menus, alleging that Appellant's specification refers to item 14 in Fig. 1 as "page number" (Playlist #xxxx) and that the Playlist numbers refers to the current menu and points to successive and previous menus pending on the user's selection. Appellant respectfully disagrees with such characterization. In Fig. 1, the item 14 is "#03000" and is clearly identified as "play-item number" in Appellant's specification, page 9, line 4 and line 9. The word "Playlist" is not part of the item 14. Therefore, it does not follow that "page numbers" are functionally equivalent to pointers to other menus.

In the Office Action, pages 14 – 15, the Examiner argued that, in Fig. 1, if PlayList #03200 was not a pointer, then the text "PlayList #03200" would only print and the sub-menu would not print because there would no "associating a page number with each page menu" involved, and that hence the PlayList and the play-item number corresponds to a pointer. Appellant respectfully disagrees with such assertion. Appellant submits that since each menu page is associated with a page number, the appropriate menu page will be selected according to the claimed invention, and thus the menu page will print.

Appellant submits that, with respect to Fig.1, the present invention refers less to the question of how to call the page number #03200, and more to the question of what

happens when on page #03200 the "more" button is pressed (see Fig. 3 and Fig. 4). In this case, the button command does not directly specify the next menu page to be displayed, as shown in Fig.4. Instead, the button command specifies a range of page numbers, which is then compared with actually available page numbers, and the page with the next available page number (in this case #03224) is selected. This is clearly different from the behavior of a pointer.

Furthermore, Appellant submits that page numbers have an implicit order, i.e. the pages can be ranked. However, a pointer does not represent any ranking of the referenced object among other objects referenced by other pointers. Therefore, "page numbers" are not functionally equivalent to pointers to other menus.

In the Office Action, page 15, the Examiner stated that the claim language does not recite that page numbers have an implicit or intrinsic order, wherein the order will allow pages to be automatically positioned in correct order when inserting and deleting pages. Appellant submits that an ordinarily skilled person in the art would understand that numbers have an implicit order, i.e. any group of numbers will automatically be positioned in the correct order, even if numbers are added or removed from the group. Therefore, Appellant submits that the claim language does implicitly recite the existence of an intrinsic order by virtue of using the word "number" in the claim. Therefore, these features do not need to be positively recited in the claim.

Appellant further submits that although Goldsmith also discloses "previous page" buttons, these refer to the history of menu usage: that is, a history of previously selected menu items is provided, and "previous page" is understood as the previously selected page (see e.g. Fig. 5 of Goldsmith). This is always a menu level that is higher than the

current level. In the present claimed invention however, "previous page" refers to the natural sequential order of pages, as created through page numbering. The page numbers bring a plurality of menu pages, and particularly pages that are on the same menu level, into a natural sequence order, so that "next page" and "previous page" buttons can be used for navigating within a current menu level. Consequently, Goldsmith does not disclose "next page" buttons other than normal submenu buttons, since the menu pages do not have a sequential order. Therefore, Goldsmith does not disclose associating menu pages with page numbers.

In the Office Action, page 16, the Examiner asserted that the claim language does not recite details about the "previous" and "next" commands. Appellant submits that the "previous" or "next" commands need not refer to a different level of hierarchy. Although examples where the "previous" or "next" command refers to a different level of hierarchy were not disclosed in Appellant's specification, this possibility needs not be excluded. The argument made by Appellant is just for clarifying the differences, since it is a consequence of Appellant's claimed feature, namely associating a page number with each menu page. Thus, Appellant submits that there is no need to positively recite these features in the claim.

As explained above, Goldsmith uses "backward" and so-called "forward" links to move between different hierarchy levels in a multi-level menu. In Goldsmith, "backward" always refers to a parent menu page that was previously selected (i.e., the next higher hierarchy level) (see paragraph [0037]), and "forward" always refers to a submenu (i.e., the next lower hierarchy level) (see paragraph [0036]). As shown in Figs. 5 – 7 of Goldsmith, each option that has a submenu will also have a "forward"

pointer. Therefore, the so-called "forward pointer" is nothing else but a link that directly points to another page.

In view of at least the foregoing reasons, Appellant submits that Goldsmith does not disclose the claimed feature: associating a page number with each menu page. Therefore, claim 1 is patentable over Goldsmith, and the rejection should be reversed.

2. Claims 13 and 15

Appellant's independent claim 13, in part, requires:

"*means for detecting a current menu page number*." (Emphasis added)

Similarly, Appellant's independent claim 15, in part, requires:

"*wherein menu pages have page numbers*." (Emphasis added)

Claims 13 and 15 are different from claim 1, however the relative argument used above for claim 1 may be applied to claims 13 and 15. Therefore, appellant essentially repeats the above arguments for claim 1 and applies them to claims 13 and 15, pointing out why Goldsmith fails to disclose the above claimed features. Thus for at least the reasons discussed above for claim 1, claims 13 and 15 are patentable over Goldsmith and the rejection should be reversed.

3. Claims 2 – 7, 12, 14 and 16 - 20

Claims 2 – 7, 12, 14 and 16 – 20 respectively depend from one of claims 1 and 13, and inherit all the respective features of claims 1 and 13. Therefore, claims 2 – 7, 12, 14 and 16 – 20 are patentable for at least the reason that they respectively depend from claims 1 and 13, with each claim containing further distinguishing features, and the rejection should be reversed.

Conclusion

As discussed above, the claims 5 and 17 are clear and definite. Accordingly, it is respectfully requested that the Board reverse the rejection of claims 5 and 17 under 35 U.S.C. §112, second paragraph.

The cited reference fails to disclose all of the claim limitations of the pending claims. Accordingly, it is respectfully requested that the Board reverse the rejection of claims 1 – 7 and 12 – 20 under 35 U.S.C. §102(b).

Respectfully submitted,

/Reitseng Lin/
By: Reitseng Lin
Attorney for Appellant
Registration No. 42,804

THOMSON Licensing Inc.
PO Box 5312
Princeton, NJ 08543-5312

Date: 22 October 2009

8.   <u>CLAIMS APPENDIX</u>

1. (Previously presented) A method for automatically generating an electronic menu including a plurality of menu pages, wherein menu pages contain selectable menu items with associated commands to be executed upon activation of the respective menu item, the method comprising

associating a page number with each menu page;

a first menu page containing at least one menu item with an associated command and associated data, wherein the command associated with the menu item comprises switching to another menu page;

defining a range of page numbers based upon said data associated with said command;

detecting the page numbers of the available menu pages; and

selecting a second menu page upon activation of said menu item for switching to another menu page, wherein the second menu page has the first or last page number from among the available menu pages within the defined range of menu pages and wherein the first and second menu pages are retrieved from different storage media.

2. (Original) Method according to claim 1, wherein defining a range of page numbers is also based upon the page number of said first menu page.

3. (Previously presented) Method according to claim 2, wherein said range is further defined by a page number of another menu page that is stored on the same storage medium as the first menu page.

4. (Previously presented) Method according to claim 1, wherein said range is defined by a placeholder within said data associated with said command.

5. (Previously presented) Method according to claim 1, wherein said data associated with said command contain a numeric value, and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page, and wherein from among the available menu pages within the defined range, the menu page with the next higher page number relative to the page number of said first menu page is selected, if the numeric value indicates a higher page number than the page number of the first menu page.

6. (Previously presented) Method according to claim 1, wherein a menu page is stored in a separate file, or in a selectable portion of a file, and the page number is determined by the name of the file, or by the name of the file and the selectable portion within the file, in which it is stored.

7. (Previously presented) Method according to claim 1, wherein the page number associated with the first or second menu page depends on user specific settings.

8 – 11. (Cancelled)

12. (Previously presented) Method according to claim 1, wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available.

13. (Previously presented) An apparatus for automatically generating an electronic menu including a plurality of menu pages, wherein each menu page contains selectable menu items with associated commands to be executed upon activation of the respective menu item, wherein the apparatus has

means for detecting a current menu page number;

means for retrieving from at least two different storage media menu related data and other data being selectable through the menu;

means for detecting from a request for displaying another menu page the allowed range of page numbers of the next menu page to be displayed;

means for detecting which of the available menu pages has the next higher or lower number; and

means for selecting said detected menu page.

14. (Previously presented) Apparatus according to claim 13, wherein detecting the allowed range of page numbers of the next menu page to be displayed comprises comparing a received number with the current menu page number, wherein the received number is defined within said request.

15. (Previously presented) Optical storage medium for storing audio-visual content and menu data for a multi-page menu, wherein menu pages have page numbers, and wherein at least a first menu page contains a command for selecting a second menu page, wherein

the command for selecting a second menu page specifies a range of menu pages to select, and a predefined rule specifies which menu page of the range of menu pages is selected next; and

for at least one page number within said range no relating menu page is stored on the optical storage medium.

16. (Previously presented) Method according to claim 2, wherein said range is defined by a placeholder within said data associated with said command.

17. (Previously presented) Method according to claim 2, wherein said data associated with said command contain a numeric value, and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page, and wherein from among the available menu pages within the defined range, the menu page with the next higher page number relative to the page number of said first menu page is selected, if the numeric value indicates a higher page number than the page number of the first menu page.

18. (Previously presented) Method according to claim 2, wherein a menu page is stored in a separate file, or in a selectable portion of a file, and the page number is determined by the name of the file, or by the name of the file and the selectable portion within the file, in which it is stored.

19. (Previously presented) Method according to claim 2, wherein the page number associated with the first or second menu page depends on user specific settings.

20. (Previously presented) Method according to claim 2, wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available.

9.   **RELATED EVIDENCE APPENDIX**

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title nor any other evidence entered by the examiner and relied upon by appellant in the appeal.

10.   RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any appeals or interferences related to the present application.